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PATENT
Attorney Docket No. 58448
#45

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
HAGENBUCH

Serial No. 08/102,531

Filed: August 4, 1993

For: APPARATUS AND METHOD
RESPONSIVE TO THE ON-BOARD
MEASURING OF HAULAGE
PARAMETERS OF A VEHICLE

Patent No. 5,327,347
Issued July 5, 1994

Attn: Office of
Petitions

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TRIUMPH PETITIONS

NOTIFICATION PURSUANT TO 37 C.F.R. §§ 1.28(b) AND (c) OF
LOSS OF ENTITLEMENT OF SMALL ENTITY STATUS AND ERROR
IN PAYMENT OF FEE AS A SMALL ENTITY

Assistant Commissioner
for Patents
Washington, D.C. 20231

Dear Sir:

Pursuant to 37 C.F.R. § 1.28(b), applicant hereby notifies the Patent and Trademark Office that he is no longer entitled to status as a small entity and that the claim for small entity status set forth in the verified statement filed May 12, 1989 is hereby withdrawn.

Calculation and Payment of Deficiency Pursuant
to 37 C.F.R. § 1.28(c)

From applicant's review of its file for the present application (now U.S. Patent No. 5,327,347), the following fees were paid pursuant to the small entity schedule after applicant was no longer entitled to the small entity status.

Filing fee - \$759.00

Issue fee - 585.00

According to the October 1, 1995 fee schedule in effect as of the date of this notification, also required by 37 C.F.R. §

1 142	665.00	CK
1 101	807.00	CK

1.28(c), the large entity amounts for the foregoing fees are as follows:

Filing fee - \$1,566.00

Issue fee - 1,250.00

Payment is attached for the sum of **\$1,472.00** for the deficiencies between the amounts paid (i.e., \$1,344.00) and the amount due (i.e., \$2,816.00) for a large entity.

Any deficiency in the enclosed payment should be charged to Deposit Account No. 12-1216.

Because the date of this notification is more than three (3) months after applicant lost its small entity status, the following is a statement pursuant to 37 C.F.R. § 1.28(c) explaining how the error in payment of the above-identified fee occurred in good faith and how and when it was discovered.

Status Of Application

This patent application was filed as a Rule 62 continuation of U.S. patent application Serial No. 07/964,126, which in turn is a Rule 62 file-wrapper continuation of U.S. application Serial No. 07/351,179 (hereinafter "the '179 application"). On July 5, 1994, this patent application issued as U.S. Patent No. 5,327,347. Attached as Exhibit A is a chronology of U.S. patent applications related to the present application pursuant to 35 U.S.C. § 120.

Statement Pursuant to 37 C.F.R. § 1.28(c)

1. How The Error Occurred In Good Faith

On May 12, 1989, a verified small entity statement was filed in the '179 (now abandoned) from which the above-identified patent application claims priority under 35 U.S.C. § 120 as a Rule 62 file wrapper continuation. At the time this statement was filed, applicant was entitled to the small entity status. More than two years after the

statement was filed, however, applicant entered into an agreement granting Caterpillar, Inc. of Peoria, Illinois, a non-exclusive license to U.S. Patent Nos. 4,839,835 and 4,831,539 (hereinafter "the '835 patent" and "the '539 patent," respectively). Caterpillar, Inc. is not entitled to small entity status.

The license agreement also provides to Caterpillar a non-exclusive license to the '179 application, which later became abandoned. However, the license agreement also granted rights to "any United States patent application filed as a continuation, continuation-in-part, divisional, reissue or reexamination" of the '539 or '835 patent, or the '179 application. Because this application is a file wrapper continuation of the '179 application and claims the filing date of the '179 application as a priority date under 35 U.S.C. § 120, this patent application may be subject to the license agreement and, as a result, not entitled to small entity status. Later license agreements with Komatsu-Dresser Company and Wiseda, Ltd. granted rights of a scope similar to that of the Caterpillar agreement.

The small entity status correctly established by the statement filed with the '179 application on May 12, 1989 was carried forward in good faith into each of the Rule 60 and Rule 62 continuations. An error occurred in good faith when applicant failed to withdraw the small entity status in the '179 application after the license to Caterpillar was executed. This error was carried forward through each of the parent patent applications and now infects the present application.

All of the patent applications in the chronology of Exhibit A filed after the date of the Caterpillar licensing agreement were either Rule 60 or Rule 62 continuations and, therefore, were prepared by tailoring standardized forms. In this regard, the initial draft of each Rule 60 or Rule 62 application was undertaken by a paralegal or legal

secretary. In either case, the undersigned attorney reviewed the initial draft for its content prior to finalizing the customized form for filing with the Patent Office. Because filing of these applications was pursuant to Rule 60 or Rule 62, a new verified small entity statement was not prepared for the applicant's signature and, therefore, the issue of whether the applications remained entitled to the small entity status became obscured.

Each of the Caterpillar, Komatsu-Dresser and Wiseda licensing agreements was executed as a confidential document and maintained in a file separate from the present patent application or its parent applications. As such, there were no copies of these licensing agreements in the parent patent application files that would serve as a reminder that the present application may not be entitled to the small entity status correctly established in the '179 application, filed May 12, 1989. Also, the negotiations with Caterpillar and later licensees Komatsu-Dresser and Wiseda focused on the '835 patent and complex issues unrelated to this application (e.g., scope of the grant, resulting in agreements of 10, 39 and 46 pages, respectively, with multiple attachments), which further obscured the effect of the licenses on the fee structure for the '179 application and the Rule 60 and Rule 62 continuations thereof.

2. How And When The Error Was Discovered

Applicant first became sensitive to the existence of an issue regarding whether the present patent application was properly entitled to maintain the small entity status established in the parent '179 patent application when considering a licensing strategy for the U.S. Patent No. 5,416,706 (hereinafter "the '706 patent"), which issued from a Rule 60 continuation of the present application (see Exhibit A). In considering an appropriate strategy for initiating a licensing program of the '706 patent, the

undersigned met with Mr. Hagenbuch, the inventor and owner, on August 14, 1995. During this meeting, the Caterpillar and Komatsu-Dresser Co. licensing agreements were discussed, including the language granting a license to patents based on continuations or continuations-in-part of the '835 patent, the '539 patent or the '179 application.

After that meeting and in the process of preparing information disclosure statements and amendments for several of the pending patent applications in Exhibit A, the undersigned realized the small entity status carried forward by the Rule 62 form may be in error in view of the apparent scope of the license agreements. The undersigned then also realized that the small entity status had been claimed throughout the chain of Rule 60 and Rule 62 patent applications and the reduced fees paid in these applications after the date of the Caterpillar agreement may also be in error.

Conclusion

For the '835 and '539 patents and the Rule 60 and 62 continuations-in-part of them identified in the chronology of Exhibit A, all Patent Office fees paid after the execution date of the Caterpillar licensing agreement (i.e., October 25, 1991) should have been paid in the amount for a large entity. For each of these patents and patent applications in which fees were paid after the date of the Caterpillar agreement, applicant is contemporaneously paying the deficiency between the amount paid and the amount due for a large entity and is also filing into the application the appropriate documents pursuant to 37 C.F.R. § 1.28.

In re Appln of HAGENBUCH
Serial No. 08/102,531

Signed at Chicago, County of Cook and State of
Illinois, on November 1, 1995.

Respectfully submitted,

By


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In re Appln of HAGENBUCH
Serial No. 08/102,531



CERTIFICATE OF MAILING

I hereby certify that this is NOTIFICATION PURSUANT TO
37 C.F.R. §§ 1.28(b) AND (c) OF LOSS OF ENTITLEMENT OF SMALL
ENTITY STATUS AND ERROR IN PAYMENT OF FEE AS A SMALL ENTITY
being deposited with the United States Postal Service as
first class mail in an envelope addressed to: Assistant
Commissioner for Patents, Washington, D.C. 20231, on the
date indicated below.

November 1, 1995
(date)

John B. Conklin

58448NOT.SES

**Chronology of Hagenbuch U.S. Patent Appln. Serial No. 08/102,531
filed August 4, 1993 (Atty. Docket 58448)**

